

The examiner states, “Currently, no claims are generic.” We request this interpretation be reconsidered under MPEP 806.04(d). For clarity on our part, we will review the relevant compositional claims structure as currently pending.

- ✓ Claims 1 – 6 are drawn to a device consistent with Fig. 1 – 3. The undercarriage is integrally molded in the base of the basket, the legs are simple, not complex, and the wheels are attached on the tips of the legs. No lower shelf is provided in the claims. The deployment means employs a scissors tongs and sliding trigger.
- ✓ Claims 11 through 29 are consistent with Figures 1 – 3 and with Figures 4 – 9. The latter depict a device in which the undercarriage is not integrally formed in the base of the basket, and the basket is detachably attached. Claims 11 through 29 are also consistent with Figures 10 – 11, and 14. Figures 10 and 11 depict an alternative mechanical gear means for deploying the legs. Figure 14 is illustrative of the broader class of “legs” disclosed in the specification (Claim 13). An argument can be made that Figures 12 – 13 also must be considered here (see Claim 29).
- ✓ Claims 31 and 35 are most consistent with Figures 12 – 13.

In reconsidering the office action’s second division, an important question is whether the disclosure as a whole describes at least one genus invention with more than one species, and if so, then whether it is claimed as such. We believe that Claim 11 is a genus claim. We believe that it reads on the invention of Figures 1-3, 4-9, 10-11, 14, and also 12 – 13 (see below).

In the specification, ¶0012 of the disclosure describes, "a mechanical combination ... having four basic elements: a lightweight shopping basket for carrying, legs and wheels, a mechanism for releasably securing the legs under the basket when not in use, and a triggering mechanism or means for releasably and deploying the legs so that the vehicle

can be wheeled at a convenient height instead of carried.” All the embodiments of the drawings meet these broad criteria.

But we also will argue that consideration of the individual drawings leads to the same conclusion. To start, we would argue that a genus claim to the functionally related inventions of Figures 1 –3 and 10 - 11 is supported. Clearly the two mechanical trains perform the releasably securing, triggering and deploying function by alternate means.

In fact, means language is reflected in our generic Claim 11, which recites, “a means for releasably securing said plurality of legs,” and “a means for triggering release and deployment of said plurality of legs.” For more detail, note in particular part numbers (on the drawings) 3.13 and 3.22, 4.13 and 4.22, 8.13 and 8.22 versus part numbers 10.29 and 10.22 (on Fig 10), which are “paired” components of analogous alternate means for releasably securing, triggering and deploying the legs. The species are generically related as means to a common function.

When a claim is written with “means for” language, we believe the Examiner will agree that it is entirely appropriate to be construed under 35 USC §112 ¶6. “Such claim shall be construed to cover the corresponding structure, material, or acts described in the specification.” All such functional means as are disclosed in the specification become candidate species of a common invention as defined in the generic means claim.

Next, we ask for reconsideration of generic status of Claim 11 with respect to Fig 3 and Fig 4. The relationship between the two illustrated embodiments is more than that of combinations and subcombinations. In the simplest sense, Fig 3 is just a sophisticated way of manufacturing what would be obtained by bolting together the combination of Fig 4. In its simplest sense, the components of Fig 4 represent an alternate intermediate in the manufacture of the device of Fig 3. Without saying too much on this, if the device of Fig 3 is deemed patentable by the office, it would seem reasonable to ask whether the device of Fig 4 is also co-patentable, or vice versa. A generic claim has been presented, and dependent claims to the alternative species are of record.

In more detail, dependent Claim 22, for example, describes a species in which an undercarriage is integrally molded with the upper basket. This corresponds to Fig. 3, and is described in the specification as, “a shopping basket (3.1) with integral molded quadrilateral frame and longitudinal beams (3.3) forming an undercarriage in the base (3.7) of the basket” (¶0080, see also ¶0035). Please compare dependent claims 24, 25, and 26 appended to Claim 11. These claims describe another species, in contrast to Claims 21 and 22, in which the basket is detachable from the undercarriage, and can be attached by fasteners. This corresponds to Fig. 4 and is supported in ¶0024 and 0036. The corresponding description in the specification (¶0081) reads, “In Figure 4, a second embodiment is shown. This embodiment differs in that a detachably attachable undercarriage (4.3) is shown which is not integral to the shopping basket (4.1). The two parts of the assembly kit are detachably attachable by means of screws or bolts (4.27).”

We take this descriptive material to support a genus claim to at least two species: the species of Fig. 3 having an integral undercarriage and the species of Fig. 4 having a detachably attachable undercarriage. Figures 5-9 also show the detachable undercarriage.

Figures 1 and 2 (which the Examiner did not distinguish from Fig 3) are pointedly indistinct as to whether the the basket has an integral or detachably attachable undercarriage. These two figures, the cartoon and the schematic, convey the genus character of the invention as claimed in Claim 11, which is purposefully silent (and thus inclusive) as to the options provided for manufacture or assembly of an undercarriage.

Claim 11 is also silent (inclusive) as to the nature of “said legs”, but a detailed supporting definition of “leg” is provided (¶0054). The inventor is his own lexicographer. We would argue that the correct reading of Claim 11 for purposes of examination is the broadest possible meaning supported by the specification that is patentable. In this interpretation, we submit, for purposes of this response, that Figures 12, 13 and also 14 are species of Claim 11. A Markush claim, properly dependent on Claim 11 and claiming analogous structural elements, was included in the set (Claim 13). Is this not another mark of a genus

claim? Claim 11 is our candidate generic claim, and we see no reason to abandon it at this early stage of the examination.

Interestingly, Claim 11 is silent (inclusive) as to a lower shelf. Dependent Claim 29 recites a device of Claim 11 further comprising a lower shelf. While not shown as a stand-alone figure, Figures 12 and 13 could be readily modified with a few clicks of a mouse to show the wheels attached to the legs instead of to the lower shelf, and an articulation attaching the lower shelf to the legs. Note that Claim 11 is also silent (inclusive) as to the precise position of attachment of the wheels. In the specification (¶0054), there is a discussion of leg types, and the statement is made that, “Any given leg may have attached wheels. ... In some embodiments, the wheels are not mounted on the legs at all, but are instead affixed on an inferior aspect of the shopping vehicle, for example a lower, deployable shelf” (emphasis added). Thus Claim 29 anticipates that some embodiments with wheels on the legs would also have a lower shelf. These instances again seem to support multiple species embodiments having the common elements of genus Claim 11.

For clarity on the question of “patentably distinct”—referencing Figures 12 – 13—it should be noted that embodiments further comprising a lower shelf are also recited as an independent claim. Claim 31, and associated dependent claim 35, were added by way of preliminary amendment. The distinction is made by the way of joining the wheels: in Claim 31 the wheels are explicitly attached to the articulating lower shelf, and in Claim 29 the attachment of the wheels is not stated (ie. is inclusive). A restriction requirement between dependent Claim 29 and Claim 31 would indicate that the inventive species with respect to point of wheel attachment are patentably distinct. Discussion in ¶0044 is relevant to this determination. The Doctrine of Claim Differentiation may also be relevant at a later stage of the prosecution. Hence, clarity in the record as to the presence or absence of a generic claim (perfect or imperfect) is very important to us.

Some species under genus Claim 11 may not be patentably distinct. For example, it seems doubtful that a handled vehicle of Claim 23 (not drawn) would be patentable over the vehicle (drawn) of Claim 3 (Fig 3). We would also want to know if the Examiner’s view

is that Claim 1 is patentable over Claim 11. After all, it is not one drawing that is patentably distinct over another, it is one claim that is patentably distinct over another. What about Claim 11, in the Examiner's view, is not a generic claim, if so?

POSITION: Our assertion here, unless challenged in all its particulars, or irreparably flawed, is that candidate generic Claim 11 (and its dependent claims) encompasses all the drawings.

We would be happy to supply a full brief enumerating the species disclosed within the scope of generic compositional Claim 11 and to discuss the relationship between the embodiments of Claim 11 and the embodiments of Claim 1, or Claim 31. However, in order to be brief and to expedite the examination on the merits, we would offer the following proposition.

We suggest that an examination be made of Claims 1 – 6. These claims read on Figures 1 through 3, nominally Group IA as provisionally categorized by the Examiner. This election is copacetic with the Examiner's Restriction Request, but does not address the questions as to whether Claim 11 is a genus claim, or whether Figures 1 – 3, 4 – 8, 10 – 11, 12 – 13 and 14 in fact represent inventive species unified by a disclosure of a genus, and whether independent Claims 1 (represented by Figure 3) and 31 (represented by Figures 12 – 13) are patentably distinct (ie. outside the genus claimed by Claim 11).

We provisionally agree to elect Claims 1 – 6 per the Examiner's proposed second division affecting the compositional claims. However, we respectfully request that the Examiner, before making the requirement final, reconsider and discuss in more detail the generic status of our generic Claim 11 with respect to the proposed division, the question as to whether Claims 1 and 31 are patentably distinct over Claim 11, reconsider the drawings individually as illustrations of a genus described by original Claim 11, and assess the support in the specification for a genus claim *sensu lato*. The arguments presented here may provide a basis for a division that preserves our generic compositional claim in all our most respects.

The Examiner's provisional acknowledgement of a generic claim will not alter our decision to commence examination of Claims 1 – 6. However, the path of subsequent prosecution may turn on the question of a generic compositional claim, and thus the importance of clarifying our record before making the Restriction Requirement final. This proposal is a bona fide attempt to advance the prosecution of this case. We respectfully await a final decision on the Restriction Requirement and reserve here the right to enter an appeal into the record if an agreement cannot be reached on the generic status of Claim 11.

Thank you very much for your consideration.

Respectfully submitted,



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